

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 21, 2004. At the time of the Office Action, Claims 1-101 were pending in this Application. Claims 1-101 were rejected. Claims 1, 47, 89 and 93 have been amended to further define various features of Applicants' invention. Claims 2, 7-8, 48 and 53-54 have been cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

Claim Objections

Claim 89 was objected to due to a typographical error. Claim 89 has been amended to depend from Claim 87 rather than from Claim 97, as suggested by the Examiner.

Independent Claims 1, 47 and 93 are Allowable over Kay.

Claims 1-3, 9-21, 47-49, 55-67, and 93-100 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,430,602 issued to Timothy Kay et al. ("Kay"). Applicants respectfully request the Examiner withdraw these rejections based at least on the amendments shown above and the following comments.

Claim 1, as amended, recites:

A method, comprising:

facilitating a mediated communication session between a first communication device associated with a first user and a second communication device associated with a second user, wherein facilitating the mediated communication session includes receiving from the first communication device a request for implementing an interactive communication session with the second user;

receiving from the second user via the second communication device a reply for accepting the request; and

in response to receiving the reply for accepting the request, implementing the interactive communication session between the first communication device and a third communication device associated with the second user, the interactive communication session enabling the second user to communicate with the first user via the third communication device.

Kay fails to disclose this combination of limitations. *Kay* discloses a method and system for interactively responding to requests sent from a user as instant messages. The system includes a message processor 12 which is connected to a data network 14 through an instant messaging (IM) port 16. (col. 4, lines 28-34). When message processor 12 receives an IM request from a user 18, the processor 12 forwards the request to a local or remotely located query response server 22. (col. 4, lines 58-61). Query response server 22 includes a natural language interpreter or other smart system capable of responding to queries and other request of an arbitrary nature related to topics within at least a specified range of issues by generating an appropriate answer. (col. 4, lines 61-66). The answer generated by query response server 22 is returned to the message processor 12, which incorporates the answer into an output message and sends the output message to the user 18 through the IM network. (col. 4, line 66 to col. 5, line 2) The output message can be forwarded to the user through any other designated means, including e-mail, fax, text messaging to wireless or hand-held devices, voice mail (via a text to speech output system), or any other type of messaging system specified by the user. (col. 5, lines 3-7).

Thus, *Kay* discloses a system for receiving an IM request from a user, forwarding the request to a local or remote query response server, receiving a response to the user's request from the local or remote query response server, and sending the response back to the user through the IM network. For example, if a user submits a request that reads "What is the weather in Sunnyvale?", the query response server would process the query by accessing a suitable Internet weather resource to obtain the weather report for Sunnyvale, and send the user an answer to the user's request. (col. 5, lines 24-31).

Thus, since there is only one user involved in the process disclosed by *Kay* (i.e., the person making the request for information), *Kay* fails to disclose a communication session between "a first communication device *associated with a first user* and a second communication device *associated with a second user*," as recited in amended Claim 1. Thus, *Kay* also fails to disclose "receiving from the first user via the first communication device a request for implementing an interactive communication session with the second user." Rather, *Kay* discloses receiving from a user a request for information, not a "request for implementing an interactive communication session with [a] second user."

In addition, because the process disclosed by *Kay* involves only one user communicating a network, *Kay* also fails to disclose “receiving from [a] second user via [a] second communication device a reply for accepting the request [from the first user].” Further, *Kay* does not disclose “implementing [an] interactive communication session between the first communication device and a third communication device associated with the second user, the interactive communication session enabling the second user to communicate with the first user via the third communication device,” as specifically recited in amended Claim 1.

For at least these reasons, *Kay* fails to disclose, teach or suggest the combination of limitations recited in amended Claim 1. Thus, Applicants respectfully request reconsideration and allowance of amended Claim 1, as well as all Claims that depend therefrom. In addition, for at least the reasons stated with regard to Claim 1, Applicants respectfully request reconsideration and allowance of amended independent Claims 47 and 93, together with all claims that depend therefrom.

If the Examiner maintains a rejection of Claim 1 based on *Kay*, Applicants respectfully request the that Examiner indicate the particular elements/text of *Kay* that may be equated with each of the elements/limitations of amended Claim 1.

Independent Claims 33 and 79 are Allowable over the proposed *Kay-Ouzounidis* combination.

Claims 33-46 and 79-92 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kay* in view of U.S. Patent Application Publication No. 2002/0007397 filed by Jan Michael Ouzounidis et al. (“*Ouzounidis*”). (Office Action, page 8). Applicants respectfully traverse for at least the reasons discussed below.

According to § 2143 of the Manual of Patent Examining Procedure, one of the basic criteria that must be met in order to establish a prima facie case of obviousness is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Based on this standard, independent Claims 33 and 79 are

allowable over the proposed *Kay-Ouzounidis* combination at least because there is no suggestion or motivation in *Kay* or *Ouzounidis*, or in the knowledge generally available to one of ordinary skill in the art, to modify *Kay* with *Ouzounidis* to arrive at the combination of limitations recited in Claims 33 or 79.

Claim 33 recites:

A method, comprising:
facilitating a voice-based mediated communication session between a first communication device and a second communication device, wherein facilitating the mediated communication session includes receiving a request for implementing a text-based interactive communication session from the first communication device;
receiving a reply for accepting the request from the second communication device;
implementing the text-based interactive communication session between the first communication device and a third communication device in response to receiving the reply for accepting the request; and
managing the interactive communication session between the first communication device and the third communication device after performing an operation for implementing the interactive communication session.

The Examiner acknowledges that *Kay* fails to disclose facilitating a voice-based communication session. (Office Action, page 11). However, the Examiner claims that *Ouzounidis* teaches a mediated communication session including facilitating a voice-based mediated communication session, at page 2, paragraph 25, through page 3, paragraph 35 of *Ouzounidis*. (Office Action, page 11). Thus, according to the Examiner, it would have been obvious to a person of ordinary skill in the art to modify the teachings of *Kay* based on *Ouzounidis* to show facilitating a voice-based mediated communication session between a first and second communication device.

However, neither *Kay* nor *Ouzounidis* suggest or motivate such a modification of *Kay*. As discussed above, *Kay* teaches a message router/processor 12 receiving an IM request from a user 18, forwarding the request to a local or remote query response server 22, receiving a response to the user's request from the local or remote query response server 22, and sending the response back to the user 18 through the IM network. For example, if a user 18 submits a request that reads "What is the weather in Sunnyvale?", the message router/processor 12

routes the request to a query response server 22, which processes the query by accessing a suitable Internet weather resource to obtain the weather report for Sunnyvale. The message router/processor 12 then sends the user 18 an answer to the user's request. (col. 5, lines 24-31).

Thus, the Examiner is presumably attempting to equate:

- (a) the user 18's computer with the "first communication device" of Claim 33;
- (b) the server hosting the Internet web sites (e.g., the Internet weather resource in the example discussed above) with the "second communication device" of Claim 33;
and
- (c) the message router/processor 12 with the "third communication device" of Claim 33.

Thus, assuming for the sake of argument that the Examiner's equating of elements is proper, in order to teach "facilitating a voice-based mediated communication session between a first communication device and a second communication device," *Kay* must be modified by *Ouzounidis* to teach a voice-based mediated communication session between the user 18's computer and the server hosting the Internet web sites that include the answer to the user 18's request (e.g., the Internet weather resource in the example discussed above).

However, *Ouzounidis* discloses a system for sending messages to a recipient via a number of different types of messaging systems. (Abstract). A first user (originator) wishing to leave a message for a second user (recipient) connects to a voice system 103, which can interpret a voice input from the first user, using a voice based communication device, such as a POTS telephone or mobile telephone. (Page 2, paragraphs 25 and 28). The voice system 103 guides the first user through a dialog session allowing the first user to leave a message for a second user (recipient) via a number of different types of messaging systems. (Page 2, paragraph 28 and page 3, paragraph 35). *Ouzounidis* does not disclose an Internet web server participating in voice-based communication with the first user. Thus, *Ouzounidis* clearly does not suggest modifying a system such as that disclosed by *Kay* to provide a voice-based

mediated communication session between a user's computer and an Internet web server. Moreover, nothing in *Kay* motivates such a modification of *Kay*.

For at least these reason, Applicants submit that the proposed modification of *Kay* in view of *Ouzounidis* is improper. Thus, Applicants respectfully request reconsideration and allowance of independent Claim 33, as well as all Claims that depend therefrom. In addition, for at least the reasons stated with regard to Claim 33, Applicants respectfully request reconsideration and allowance of independent Claim 79, together with all claims that depend therefrom. If the Examiner maintains his position that *Kay* may be modified in view of *Ouzounidis* to arrive at the limitations recited in Claims 33 and 79, Applicants respectfully request the Examiner indicate the particular portions of *Kay* or *Ouzounidis* that suggest the Examiner's proposed modification of *Kay*.

Dependent Claims 4, 50 and 101 are Allowable over the proposed *Kay-Kimura* combination.

Claims 4, 50 and 101 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kay et al.* in view of U.S. Patent 5,758,280 issued to Misa Kimura ("*Kimura*"). (Office Action, page 7). Applicants respectfully submit that Claims 4, 50 and 101 are allowable over the proposed *Kay-Ouzounidis* combination at least because neither *Kay* nor *Kimura* discloses, teaches or suggests the limitations of amended independent Claims 1, 47 or 93 (from which Claims 4, 50 and 101 depend) discussed above with reference to the rejection of Claims 1, 47 and 93 under 35 U.S.C. § 102(e).

Dependent Claims 5-6 and 51-52 are Allowable over the proposed *Kay-Ouzounidis* combination.

Like Claims 33-46 and 79-92 discussed above, Claims 5-8 and 51-54 were also rejected under 35 U.S.C. §103(a) as being unpatentable over the proposed *Kay-Ouzounidis* combination. (Office Action, page 8). Claims 7-8 and 53-54 have been cancelled without prejudice or disclaimer. Applicants respectfully submit that Claims 5-6 are allowable over the proposed *Kay-Ouzounidis* combination at least because neither *Kay* nor *Ouzounidis* discloses, teaches or suggests the limitations of amended independent Claims 1 or 47 (from

which Claims 5-6 and 51-52 depend) discussed above with reference to the rejection of Claims 1 and 47 under 35 U.S.C. § 102(e).

Dependent Claims 22-32 and 68-78 are Allowable over *Kay*.

Claims 22-32 and 68-78 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kay*. (Office Action, page 15). Applicants respectfully submit that Claims 22-32 and 68-78 are allowable over *Kay* combination at least because *Kay* fails to disclose, teach or suggest the limitations of amended independent Claims 1 or 47 (from which Claims 22-32 and 68-78 depend) discussed above with reference to the rejection of Claims 1 and 47 under 35 U.S.C. § 102(e).

Double Patenting Rejection

The Examiner provisionally rejected Claims 1-101 based on the judicially created double patenting doctrine over Claims 33-95 of co-pending Application Serial Number 09/829,515 (hereinafter “515 application”). Applicants respectfully traverse the rejection. However, to reduce the cost and time required to obtain patent protection, a Terminal Disclaimer filed in compliance with 37 C.F.R. 1.32(b) is attached hereto. The Terminal Disclaimer is offered in the event the Examiner converts the provisional rejection to a rejection based on non-statutory double patenting grounds. The ‘515 application and the instant patent application are commonly owned by SoloMio Corporation.

Information Disclosure Statement

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with a copy of the reference and a check in the amount of \$180.00, for the Examiner’s review and consideration.


CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of Claims 1, 3-6, 9-47, 49-52 and 55-101, as amended.

Applicants believe there are no additional fees due, however, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants


Paula D. Heyman
Reg. No. 48,363

SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.
CUSTOMER ACCOUNT NO. **31625**
512.322.2581
512.322.8328 (fax)

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